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In re Application of :
Vega et al. :
Serial No.: 10/022,249 : PETITION DECISION
Filed: December 17, 2001 :
Attorney Docket No.: 17109-002001 / 911 :

This is in response to the petition under 37 CFR § 1.181, filed May 25, 2007, requesting reconsideration and removal of the finality of the Office action of May 9, 2007.

BACKGROUND

The examiner mailed a non-final Office action on September 7, 2006, setting a three month shortened statutory period for reply. In this action, claim 4 was objected to for being in improper dependent form. Claims 1-21 and 42-44 were rejected under 35 U.S.C. 112, second paragraph as being indefinite. Claims 1-6, 8-23, 30, 32, 33, and 42-44 were rejected under 35 U.S.C. 102 (b) as being anticipated by Giver et al. Claims 32 and 33 were rejected under 35 U.S.C. 103 (a) as being unpatentable over Giver et al. Claims 7, 24, and 27-29 were rejected under 35 U.S.C. 103 (a) as being unpatentable over Giver et al. in view of Berlioz et al. Claims 25 and 26 were rejected under 35 U.S.C. 103 (a) as being unpatentable over Giver et al. in view of Berlioz et al., further in view of Rivet et al. Claim 31 was rejected under 35 U.S.C. 103 (a) as being unpatentable over Giver et al. in view of Persson et al.

In response to the non-final Office action of September 7, 2006, applicants amended claims 1, 14, 15, 22-24, 27, 30, and 42-44. Claims 4, 11, and 13 were cancelled. Applicants also argued the rejections set forth in the action.

The examiner mailed a final Office action on May 9, 2007, setting a three month shortened statutory period for reply. In this Office action, claims 1-3, 5, 6, 8-10, 12, 14-21, 22, 23, 32 and 33 were newly rejected under 35 U.S.C. 103 (a) as being unpatentable over Blazquez et al in view of Giver et al. Claims 7, 24, and 27-29 were newly rejected under 35 U.S.C. 103 (a) as being unpatentable over Blazquez et al in view of Giver et al., and further in view of Berlioz et al. Claim 25 and 26 were newly rejected under 35 U.S.C. 103 (a) as being unpatentable over Blazquez et al in view of Giver et al., in view of Berlioz et al., and further in view of Rivet et al.

Claims 30 and 31 were newly rejected under 35 U.S.C. 103 (a) as being unpatentable over Blazquez et al in view of Giver et al., and further in view of Persson et al.

In response thereto, applicants filed this petition requesting reconsideration and removal of the finality of the Office action of May 9, 2007.

DISCUSSION

Applicants argue the final Office action of May 9, 2007, introduces a new ground of rejection under 35 U.S.C. 103 (a) that could have been applied in a previous Office action. Hence, applicants point out it was not necessitated by amendment and should not have been made final.

Applicants' argument is persuasive. The examiner has newly rejected the claims over Blazquez et al. in view of Giver et al. Applicants point out that in response to the first Office action, claim 1 was amended to incorporate the limitations of claim 13, which stated the nucleic acid molecules in each set are produced by changing one codon in the target protein to a pre-selected codon, whereby the nucleic acid molecules in each set encode proteins. Applicants point out that claim 2 depends from claim 1, and recites that the set of nucleic acid molecules is individually designed and synthesized. Hence, claim 2 as pending is essentially the same as previously pending claim 13. Applicants also point out that the new ground of rejection is set forth because it allegedly addresses the limitations added to claim 1, and hence dependent claims such as claim 2. However, as pointed out by applicants, this limitation was previously in claim 13, which is essentially the same as claim 2. Thus, it could have been so-rejected. As a result, applicants arguments are persuasive.

DECISION

DECISION

The petition is **GRANTED.**

This application will be forwarded to the examiner for an action not inconsistent with this decision.

Should there be any questions about this decision please contact Marianne C. Seidel, by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile sent to the general Office facsimile number, 703-872-9306.



Christopher Low
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